

REMARKS

Request for reconsideration and allowance of all the pending claims are respectfully requested in light of the amendments and following remarks. Claims 1-19 remain pending herein and stand rejected.

Claims 1, 2, 9-11, 18 and 19 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Huard et al. (USPPA 2004/0259630) in view of Smith (US Pat. No. 6,580,914), and further in view of Meade (US Pat. No. 7,206,559). Claims 3-8 and 12-17 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Huard in view of Smith and Meade, and further in view of O'Neil (US 2002/0107027).

Applicant respectfully disagrees with, and explicitly traverses, the Examiner's reason for rejecting the claims. A claimed invention is *prima facie* obvious when three basic criteria are met. First, there must be some suggestion or motivation, either in the reference themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings therein. Second, there must be a reasonable expectation of success. And, third, the prior art reference or combined references must teach or suggest all the claim limitations.

With regard to claim 1, this claim recites:

1. A method for providing user data pertaining to a user of a mobile terminal to a recommender system of a consumer electronic device, the method comprising the steps of:

determining, by the terminal, a current location of the terminal, wherein said current location is determined after receiving a initiating signal, said initiating signal being one of a user input and a received signal;

saving, in the terminal, an identifier of the determined location, based on a longevity of said terminal in an area proximate said current location; and

informing, by means of the terminal, said recommender system of a consumer electronic device of the determined location.

As indicated above, claim 1 recites a method for providing user data pertaining to a user of a mobile terminal to a recommender system of a consumer electronic device. The claim further recites determining a terminal location and informing the recommender system of a consumer electronic device of the determined location. Thus as recited in the claim, all of the above described activities are performed in the terminal itself. Claim 10 recites a mobile terminal device having corresponding features. Claim 10 has been amended to more clearly recite that the terminal itself contains the structure for performing the functions described. Support for this amendment is found, *inter alia*, in the language of claim 1, and in Fig. 1 and its corresponding description in the specification.

The advantages of a recommender system that makes use of this location data is illustrated in paragraph [0003] of the published application:

It is an object of the invention to furnish to a recommender of a consumer electronic (CE) device information about the past location of a mobile terminal of the user. The recommender may then propose content related to the past location.

Paragraph [0025] provides an example of the utility of this aspect of the invention:

Once the user returns home, a Bluetooth connection is automatically and seamlessly made as the user, and therefore his phone 104, comes within the Bluetooth effective range of the other Bluetooth device in the TV 164. The information saved for transmission in the above embodiments is then automatically transferred by means of this connection to the TV 164 and then to the recommender system 168. The recommender 168 may surmise from the region identifier "Spain" and from the sub-region identifier "Barcelona" that the returning traveler might, for example, fancy seeing a documentary on Barcelona/Spain. She might smile and say "I've been there."

The Office Action relies on Huard as the primary reference against the claimed invention. Huard relates to a method and system for rewarding a user's interest in an activity. In particular, Huard relates to a central location by which various inputs are received and processed to reward prizes to various users based on their (gambling) activities (see for example, paragraph [0023]). Huard does describe how a mobile terminal may be employed in the obtaining of user location information [0017]. However as acknowledged in paragraph 4 of the Office Action: "Huard in view of Smith fails to explicitly teach that the recommender [sic] being a system of an actual consumer device."

Meade is then introduced to teach a mobile device "being used to apply and update user preferences in appliance and consumer devices." Meade discloses a system for controlling an appliance by a mobile computing device by determining an available content for the appliance, selecting the content used by the appliance and applying user

preferences to the appliance. The Office Action points to col. 8, lines 51-54 of Meade as somehow, in combination with Huard and Smith, teaching the claim element “informing, by means of the terminal, said recommender system of a consumer electronic device of the determined location.” This section of Meade merely describes Fig. 4 wherein program recorder 110 has TIVO capability and VCR capability. There is nothing in Meade (nor in Huard or Smith) which relates to a recommender system of a consumer electronic device – much less how determined locations of a mobile terminal are provided thereto. In fact neither Huard nor Smith nor Meade even employs the word “recommender” (or “recommend” or “suggestion”).

Recommender systems for consumer electronic devices are well known in the art. As recited in paragraph [0002] of the published application: “More and more, consumer electronic (CE) devices are able to adapt to personal needs of the user. Recommender systems, which are integrated into CE devices like a television (TV) or a set-top box, afford an exceptional degree of personalization for the devices. The recommender for such devices works as an electronic guide/butler that helps the user to choose or filter programs or content that he/she may like [emphasis added].” None of the prior art references address such a device. While Meade mentions a TIVO as a recording device, no where does he teach a recommender system. Moreover, none of the prior art references teach or suggest how determined locations of a mobile terminal are provided to such a device (nor for what purpose).

Applicants respectfully submit that the combination of Huard Smith and Meade fail to teach the features of claim 1, to include the recommender system of a consumer electronic device being informed by a mobile terminal of the location of the mobile terminal, said location and duration at that location being determined by the mobile terminal.

Accordingly as an initial matter, applicants submit that the Huard reference fails to teach the elements of the claimed invention, contrary to the assertions of the Office Action. Having shown that the combined device resulting from the teachings of the cited references does not include all the elements of the present invention, Applicant submits that the reasons for the Examiner's rejections of the claims have been overcome and can no longer be sustained. Applicant respectfully requests reconsideration, withdrawal of the rejection and allowance of the claims.

Moreover the combination of Huard and Meade cannot sustain a §103 obviousness rejection as there is no motivation to combine these teachings. In order to establish a *prima facie* case of obviousness, generally three basic criteria must be met;

1. there must be some **suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings;
2. there must be a reasonable expectation of success; and

3. the prior art reference must teach or suggest all the claim limitations. The **teaching or suggestion** to make the claimed combination and the reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure. *In re Vaeck* (citation omitted).(emphasis added).

However, in addressing obviousness determination under 35 USC §103, the Supreme Court in *KSR International v. Teleflex Inc.* (citation omitted) reaffirmed that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." (citation omitted). The Court stated that "it can be important to identify a reason that would have prompted a person ...to combine the elements in the way the claimed new invention does ... because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense is already known. (citation omitted). The Court further addressed the standard for obviousness that had been imposed in decisions rendered by the CAFC in that there must be some teaching, suggestion or motivation (TSM) to combine the known elements in the same manner set forth in the claims and found that the TSM to combine provides a "helpful hint" in determining whether claimed subject matter is obvious. The Court however stated that the application of the TSM test is not to be applied in a rigid manner. Rather, the Court favored a more expansive view of the sources of evidence that may be considered in determining an apparent reason to combine known elements. Hence, the Court upheld precedent that "when prior art references require a selected combination to render obvious, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest

the desirability and, thus, the obviousness, of making the combination." Uniroyal Inc. v. Rudkin-Wiley Corp., (citation omitted).

Meade discloses a system for controlling an appliance by a mobile computing device by determining an available content for the appliance, selecting the content used by the appliance and applying user preferences to the appliance. Huard relates to providing prizes to gamblers based on their monitored activities. Huard discloses that one aspect of such monitoring, location determination, may be performed by a remote device. Such a remote device of limited functionality, even in combination with Smith, is clearly distinguishable from the mobile computing device of Meade. Moreover, what "user preferences" are being provided by Huard's terminal? What aspect of Huard relates to an appliance and its preferences as taught by Meade?

In addressing the obviousness rejection under 35 USC §103, the *KSR* Court did not diminish the requirement of objective evidence of obviousness. Rejections on the grounds of obviousness cannot be sustained by mere conclusory statements as there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.

In this case, the Examiner has selected elements from different prior art references to find elements recited in the claims. However, other than the conclusory statement that it would be obvious to incorporate the teachings of Meade and Smith into the teaching of Huard, the Office has failed to provide any objective teaching or motivation to modify

the Huard reference to properly address the claim features.

Accordingly, with regard to the subject matter recited in claims 1 and 10, Applicant respectfully submits that pursuant to an expansive interpretation of the three basic criteria necessary to show obviousness, a *prima facie* case of obviousness has not been set forth because the combination of the cited references has been impermissibly selected using the teachings of the instant application as a blueprint without any suggestion or reason for such combination.

In this case, Applicant believes that with regard to the referred-to claims, the Examiner has impermissibly incorporated the teachings of the present invention in the cited reference to reject the claims. Accordingly, Applicant submits that the reasons for the Examiner's rejections of the claims have been overcome and the rejection can no longer be sustained. Applicant respectfully requests reconsideration, withdrawal of the rejection and allowance of the claims.

In view of the foregoing discussion, the Office Action has failed to make out a *prima facie* case of obviousness, instant independent claim 1 is allowable, and the rejection should be withdrawn. Independent claim 10 recites similar features and is deemed patentable for at least the same reasons.

Claims 2-9 and 11-19 are dependent from one of the independent claims discussed above, and are believed allowable for at least the same reasons and any

rejections thereof should be withdrawn. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

For all the foregoing reasons, it is respectfully submitted that all the present claims are patentable in view of the cited references. A Notice of Allowance is respectfully requested.

Respectfully submitted,

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